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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,535	01/27/2004	Takumi Hatsuda	46277	8914

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EXAMINER	
FEELY, MICHAEL J	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/764,535	HATSUDA ET AL.	
	Examiner	Art Unit	
	Michael J. Feely	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *42,43 and 46-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *42,43 and 46-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/945,812.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0104*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Pending Claims

Claims 42, 43, and 46-52 are pending.

Priority

1. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/945,812 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 42, 43, and 46-52 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishizaki et al. (US Pat. No. 6,254,990).

The applied reference has a common assignee with the instant application; however, the inventive entity is different. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 42, 43, and 48-50, Ishizaki et al. disclose: ***(42 & 43)*** a water absorbent resin (Abstract),

- which is surface-crosslinked with a surface-crosslinking agent including at least a polyhydric alcohol (column 18, line 31 through column 20, line 4; Examples 1 & 2: column 28, line 37 through column 29, line 18),

- wherein the water-absorbent resin before surface-crosslinking is obtained by polymerizing hydrophilic monomers comprising a major proportion of either or both of acrylic acid and its salt *(neutralized product)* (column 6, line 35 through column 7, line 48; Examples 1 & 2: column 28, line 37 through column 29, line 18),
- where the water-absorbent resin has a particle size distribution such that the ratio of particles having particle diameters of smaller than 150 μm is not more than 5 weight percent (column 9, line 59 through column 10, line 10; Examples 1 & 2: column 28, line 37 through column 29, line 18),
- and exhibits an absorption capacity without load of not less than 30 g/g (column 10, lines 33-56; Examples 1 & 2: column 28, line 37 through column 29, line 18).

Ishizaki et al. do not explicitly disclose:

- (a) the single-layer absorption capacities, as set forth in claims ***(42 & 50)***;
- (b) the index of uniform surface-treatment of not less than 0.70, as set forth in claim ***(43)***;
- (c) the L value of light index measured with a spectrometer of not less than 85, as set forth in claims ***(48 & 49)***;
- (d) the "a" value representing chromaticness index in the range of –2 to 2, as set forth in claims ***(48 & 49)***; and
- (e) the "b" representing chromaticness index in the range of 0 to9. as set forth in claims ***(48 & 49)***.

However, it appears that all of these properties, (a) through (e), would have been inherently present in the water-absorbent resin of Ishizaki et al. This because the material and

quantity limitations of the instant invention are fully satisfied by the disclosure *(including Examples 1 & 2)* of Ishizaki et al.

It has been found that, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present – *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, the composition of Ishizaki et al. would have inherently featured properties (a) through (e), as set forth in instant claims 42, 43, and 48-50. This is because the material and quantity limitations of the instant invention are fully satisfied by the water-absorbent resin of Ishizaki et al., and it has been found that a chemical composition and its properties are inseparable.

Regarding claims 46, 47, 51, and 52, Ishizaki et al. disclose similar particle size properties to those set forth in instant claims 46, 47, 51, and 52 *(see column 9, line 59 though column 10, line 10)*; however, there is no explicit disclosure of a particle size distribution, wherein:

(a) the ratio of particles having particle diameters of 600 to 300 μm is in the range of 65 to 85 weight % *(measured by sieve classification method)*, and

(b) the ratio of particles having particle diameters of 300 to 150 μm is in the range of 10 to 30 weight % *(measured by sieve classification method)*.

Examples 1 & 2 *(see column 28, line 37 through column 29, line 18)* use a starting material having a particle size distribution of 600 to 800 μm and an average particle size 700 μm.

The simultaneous pulverization and surface crosslinking steps increased specific surface area and decreased average particle size. Specifically, the simultaneous pulverization and surface crosslinking steps introduced 1-2 weight % of fine particles of 150 μm or below and decreased the average particle size to 660-640 μm. This data is evidence to suggest that the materials set forth in Examples 1 & 2 of Ishizaki et al. would have inherently featured the particle size distribution values (a) & (b), as set forth in instant claims 46, 47, 51, and 52.

Therefore, the composition of Ishizaki et al. would have inherently featured particle size distribution values (a) & (b), as set forth in instant claims 46, 47, 51, and 52. This is because Examples 1 & 2 of Ishizaki et al. use starting materials having a particle size distribution of 600 to 800 μm (average of 700 μm) that undergo the simultaneous steps of pulverization and surface-crosslinking, resulting in the introduction of 1-2 weight % of fines (150 μm or below) and the reduction of average particle size to 660-640 μm.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J. Feely
Primary Examiner
Art Unit 1712

February 20, 2006

MICHAEL FEELY
PRIMARY EXAMINER